

REMARKS

Applicants gratefully thank Examiner Fredman for taking the time on February 12, 2004 to discuss the pending office action. In response to the Office Action mailed August 14, 2003, Applicants submit the following Amendment and Response. Claims 73, 77, 81-82, 85-86, 88-89, 100-101, 105, 109-110, 113-114, 116-117, and 128 have been amended. Claims 73-77, 81-89, 91, 92, 94, 96-98, 100-105, 109-117, 119, 120, 122, 124-126, and 128 remain pending. Support for these amendments can be found in the specification at, e.g., page 9, line 31 – page 10, line 24 and page 10, line 32 – page 11, line 17. Therefore, these amendments are made without the addition of new matter.

35 U.S.C. § 112

Claims 73-77, 81-89, 91, 92, 94, 96-98, 100-105, 109-117, 119, 120, 122, 124-126, and 128 were rejected as being allegedly indefinite under 25 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Claims 73 and 101 have been amended to specify that the sample comprises “a first and a second detectable analyte.” As stated in the specification, the detectable analyte can be a single molecule or a pair of molecules associated with each other (see, e.g., page 7, lines 15-29). Applicants realize that the term “recognizes” in claim 73 is being interpreted by the examiner to y form of recognition, whether hybridization, Van de Waal’s interaction, or covalent linkages for the purposes of the prior art.

Art Rejections

Claims 73-77, 81-89, 92, 94, 96-98, 100-105, 109-117, 120, 122, 126, and 128 were rejected as being allegedly anticipated under 25 U.S.C. § 102(b), by Urdea et al. (U.S. Patent No. 5,635,352). Claims 91, 96-98, 119, 124 and 125 were rejected as being allegedly unpatentable under 25 U.S.C. § 103(a), over Urdea et al. as applied above and further in view of Lizardi et al. (U.S. Patent No. 6,143,495).

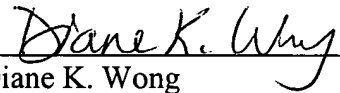
Claim 73 and 101 both specify that a sample is provided that comprises “*a first and a second detectable analyte.*” Applicants respectfully assert that none of the cited references teach or suggest a process for detecting two analytes in the sample. Urdea et al. discloses an assay involving the detection of a single analyte. As seen in Figures 8-13, only a single target molecule is depicted. (“In this embodiment, the two distinct capture extenders have distinct first nucleotide sequences complimentary to distinct but proximate segments of analyte” emphasis added, Col. 13, lines 46-49). With regard to Fig. 8, Urdea et al. further states that “[t]he only requirement is that the assay be structured such that the target binds to the solid support with a melt temperature greater than that of the capture extenders binding to the capture probe.” (emphasis added) (Col. 14, lines 16-19) The examiner has cited the amplification marker as being the “second marker.” (See Office Action., page 3). Applicants respectfully argue that the amplification multimer is not part of the sample, but rather is added later to aid in the detection of the target or analyte. (See Col. 11, line 35 – Col. 12, line 2) Urdea et al.. notes that an amplification multimer “is then optionally added to the solid phase-analyte probe-complex under hybridization conditions to permit the multimer to hybridize to the LEs” (Col. 11, lines 50-54). Claims 74-100 and 102-128 depend from claims 73 and 101, respectively. Therefore, claims 74-100 and 102-128 are patentably distinct from the cited art for the

same reasons applicable to claims 73 and 101. Accordingly, applicants respectfully request withdrawal of the rejections and reconsideration of the claims as amended.

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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